

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) A-6689 (191910-1590)
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature_____	Application Number 09/693,790	Filed October 20, 2000
Typed or printed name _____	First Named Inventor Jerding, et al.	Art Unit 2623
	Examiner Shang, Annan Q.	

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- applicant/inventor.
- assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- attorney or agent of record.
Registration number _____.
- attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 48,472

/Karen G. Hazzah/

Signature

Karen G. Hazzah

Typed or printed name

(770) 933-9500

Telephone number

10/27/2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

<input checked="" type="checkbox"/>	*Total of <u>1</u> forms are submitted.
-------------------------------------	---

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:
Jerding et al.

Serial No.:
09/693,790

Filed:
October 20, 2000

For:
**Integrated Searching System for
Interactive Media Guide**

Group Art Unit:
2623

Examiner:
Shang, Annan Q.

Docket No.:
A-6689 (191910-1590)

REMARKS IN SUPPORT OF
PRE-APPEAL BRIEF CONFERENCE

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant submits the following remarks in support of a Request for Pre-Appeal Brief Conference.

REMARKS

Applicant respectfully submits that the rejections of the claims in the outstanding final Office Action (mailed July 25, 2008, Paper No. 20080716) are clearly factual error. Applicant presents a summary of these errors in this section, then provides further detail below.

One instance of clear error is the contention that recording programs to one device (a VCR) and storing EPG data to a different device (hard disk or flash memory) is the same as recording media programs on the same device that stores media information corresponding to the recorded media programs. Another instance of clear error is the contention that searching an EPG which is stored on one device is the same as searching first and second storage devices. Yet another such instance of clear error is the contention that searching the Internet is the same as searching first and second storage devices, where the user is enabled to record media programs on the first storage device.

1. Rejection of Independent Claim 117 under §102: *Nishikawa et al.* (U.S. 5,828,370)

- a. *Nishikawa et al.* does not disclose “enabling a user to record a first set of media programs in a first storage device associated with a digital personal video recorder (PVR); storing media information corresponding to the recorded first set of media programs in the first storage device”

The plain language of claim 117 (reproduced above) indicates that media programs are recorded on the same device that stores media information corresponding to the recorded media programs. In *Nishikawa et al.*, the only device on which programs are stored is a video cassette recorder (VCR): “[t]he GUI includes a TV Planner icon which, if selected by the user, causes the television [sic] to display a monthly calendar [sic] (or recording/reminder list) that indicates which programs are purchased and/or selected for recording by a VCR” (Abstract.) Thus, the rejection of claim 117 using *Nishikawa et al.* implicitly alleges that the VCR is the “first storage device”. However, there is no teaching in *Nishikawa et al.* of the VCR being used to store media information corresponding to the recorded media programs.

In the Response to Arguments section, the final Office Action contends that “DSS/Web TV Receiver 12, DSS/Internet data (EGP data, website data, etc.), stores the data in various storage units...The guide or GUI data and the media data is stored in the storage devices”. (final Office Action, p. 2.) This passage appears to contend that EPG data or website data corresponds to the “media information corresponding to the recorded first set of media programs”.

Applicant assumes (for the sake of argument) that EPG data is properly understood as “media information” as recited in claim 117. As discussed above, the Office Action has interpreted the VCR to be the “first storage device”. Such an interpretation would also require the EPG data to be stored on the VCR, since claim 117 recites “storing media information corresponding to the recorded first set of media programs in the first storage device”. Yet *Nishikawa et al.* does not teach that EPG data is stored to the VCR, instead teaching that EPG data is stored to HDD 228, flash memory 230, or SDRAM 232. (*Nishikawa et al.*, Col. 6, line 50 to Col. 7, line 5; Col. 9, line 50 to Col. 10, line 15.) Thus, the rejection of claim 117 is clearly factual error.

b. *Nishikawa et al.* does not disclose “responsive to the user entering a search term, searching the first and second storage devices for media information having a high level of correlation with the search term”

The plain language of claim 117 (reproduced above) indicates that searching applies to the first and second storage devices. As shown above, the Office Action has interpreted the VCR to be the “first storage device”. Thus, the rejection of claim 117 using *Nishikawa et al.* implicitly alleges that the VCR is the “first storage device”. However, there is no teaching in *Nishikawa et al.* that searching applies to the VCR.

The Office Action (p. 3) alleges that this “searching” feature is disclosed in *Nishikawa et al.* at Col. 2, lines 6-26, Col. 14, line 53-Col. 16, line 19. The only mention of “searching” occurs in the last cited portion (Col. 14, line 53-Col. 16, line 19). In this portion, *Nishikawa et al.*

discloses two types of searches: searching the electronic program guide and searching the Internet. Applicant can find no teaching in *Nishikawa et al.* that the EPG is stored in two devices. Therefore, Applicant respectfully submits that a search of the EPG is not a search of the “first and second devices” claim 117. A search of “the Internet” clearly is not a search of the first and second devices referred to in claim 117, where the user is enabled to record media programs on the first storage device. Nor is a general search for “Internet search terms” the same as a search for “media information”. Thus, the rejection of claim 117 is clearly factual error.

CONCLUSION

Favorable reconsideration and allowance, or the re-opening of prosecution on the merits, of the present application and claims 117-128, 130, 131, 149-163, and 165-187 is hereby courteously requested.

Respectfully submitted,

By: /Karen G. Hazzah/

Karen G. Hazzah, Reg. No. 48,472

**THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, L.L.P.**

600 Galleria Parkway, SE
Suite 1500
Atlanta, Georgia 30339-5948
Tel: (770) 933-9500
Fax: (770) 951-0933